

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventer : Kelly, D.P.

Application No. : 10/540,597

Filed : January 18, 2006

For : **DIGITAL BROADCAST METHOD AND SYSTEM FOR
SUPPORTING DVD RECORDING AND RELEVANT RECEIVING AND
RECORDING METHOD AND DEVICE**

REPLY BRIEF

On Appeal from Group Art Unit 2425

Dan Piotrowski
Registration No. 42,079

Date: July 21, 2010

/Thomas J. Onka/
By: Thomas J. Onka
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Dear Sir:

This Reply Brief is responsive to the Examiner's Answer of May 28, 2010. This Brief is responsive to new points raised in the Examiner's Answer.

EXAMINER'S ANSWER SECTIONS (1)-(9)

The Appellant and the Examiner appear to be in agreement concerning Sections (1)-(5), (7), and (8) of the Appeal Brief and the Examiner's Answer.

EXAMINER'S ANSWER SECTION (10) – RESPONSE TO ARGUMENT

Appellants respectfully submit that the rejection of claims 1, 2, 8-10, 15-18 and 20 under 35 USC 103(a) as being unpatentable over Maeda et al. (U.S. Patent 6,556,546) B1 in view of Mao et al. (U.S. Patent No. 6,886,178 B1) and Oetzel (US Pub 2003/0193520), and claims 6, 7, 13 and 14 under 35 U.S.C. 103(a) over Maeda in view of Mao and Oetzel and in further view of Rotem et al. (U.S. Patent No. 7,043,484) and claim 19 under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of Mao and Oetzel and further in view of Na (US Patent 6,504,996) is in error.

It is respectfully submitted that in order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.
In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

In *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**." *KSR*, 82 USPQ2d 1385 at 1396 (emphasis added).

Further, MPEP 2143 states:

"If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

Independent claim 1 recites the limitations of "...wherein said navigation data stream includes at least one of, in-stream data and out-stream data, data for searching and data for generating menus *wherein the navigation data also includes data for reproduction control...*" Independent claims 8, 15 and 18 recite similar limitations.

The Examiner's Answer indicates that the combination of Maeda and Mao fails to disclose the limitation of "*wherein the navigation data also includes data for reproduction control.*" The addition of Oetzel fails to cure the infirmities of Maeda and Mao.

The Examiner's Answer indicates that "Oetzel discloses (0006, ¶0016 and claim 27) that the DVD program material transmitted from the server workstation includes audio/video data and control data that defines the way the content is organized and the way in which user input will affect the navigational flow through the audio/video data as represented in Fig. 2." Appellants read ¶0006 to teach "a DVD playback device work with two basic categories of data..." (1) "presentation data is the data that is actually seen or heard" and (2) "Logical data defines that way the content is organized, and also the way in which user input will affect the navigational flow through the presentation data." Appellants read ¶0016 to teach "The logical data created in authoring is also organized into a set of files that can be read and interpreted by a playback device...." Claim 27 recites similar teachings.

Although, the logical data defines content organization, navigation of the presentation, nothing therein teaches or even implies "*data for reproduction control.*" Thus, Oetzel includes navigation data (for playback control), its navigation data does not have reproduction control data that is used to limit the number of times the DVD may be copied. Nothing in Oetzel teaches how it can limit the number of times the DVD may be copied with its logical data.

Since Maeda, Mao and Oetzel, alone or in combination, fail to disclose each and every element claimed, Appellant submits that the reason for the Examiner's rejection of claims 1, 8, 15 and 18 has been overcome and can no longer be sustained. Appellant respectfully requests reconsideration, withdrawal of the rejection and allowance of claims 1, 8, 15 and 18.

In the Office Action, claims 6, 7, 13 and 14 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Maeda in view of Mao and Oetzel and in further view of Rotem et al. (U.S. Patent No. 7,043,484). Claim 19 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Maeda in view of Mao and Oetzel and in further view of Na (U.S. Patent No. 6,504,996).

With regard to the dependent claims 2, 6-7, 9, 13, 14, and 16-20 these claims ultimately depend from one of the independent claims, which have been shown to be allowable in view of the cited references. Accordingly, claims 2, 6-7, 9, 13, 14, and 16-20 are also allowable by virtue of their dependence from an allowable base claim.

For the reasons set forth above, in the Appeal Brief, and in the Reply Brief, it is submitted that no claims are anticipated by any of the references of record and that all claims are patentable over the references of record.

An early Decision reversing the Examiner's rejection of all claims is requested.

Respectfully submitted,

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Date: July 21, 2010

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